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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,623	09/15/2003	Yi-Ting Nancy Hsu	MR1841-66	7934
4586	7590	11/23/2005	EXAMINER	
ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043			GREENE, JASON M	
			ART UNIT	PAPER NUMBER
			1724	
DATE MAILED: 11/23/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/661,623

Applicant(s)

HSU, YI-TING NANCY

Examiner

Jason M. Greene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Drawings***

1. The drawings were received on 31 August 2005. These drawings are acceptable.

#### ***Terminal Disclaimer***

2. The terminal disclaimer filed on 31 August 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,743,271 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Response to Arguments***

3. Applicant's arguments, see page 7, line 2 to page 9, line 7, filed 31 August 2005, with respect to the rejection(s) of claim(s) 1-4 under 35 USC 102(b) as being anticipated by Zhou et al. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. Specifically, while Zhou et al. teaches using rare earth elements

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of the lanthanum series (atomic numbers 57-71), the reference teaches the rare earth elements being used in combinations with elements of the 2<sup>nd</sup>-5<sup>th</sup> periods of the Mendeleev periodic table. In these combinations, the rare earth elements are encapsulated by the other elements and the compositions require electrical stimulation to emits ions. The Examiner agrees with Applicants that the reference fails teach the specifically recited rare earth elements being in an unencapsulated, exposed state wherein the specific rare earth elements emit ions in a natural (non-energized) state. Zhou et al. also teaches an embodiment wherein cerium or yttrium comprises at least 10 percent of the compound in col. 6, lines 18-29. However, Applicants' amendment to claim 1 has been treated as though cerium and yttrium are no longer covered by the claim language.

4. Applicant's arguments filed 31 August 2005 with regard to the Takimoto reference have been fully considered but they are not persuasive. Specifically, the Examiner notes that the Terminal Disclaimer filed on 31 August 2005 is insufficient to overcome the Takimoto reference. As noted in the previous action, the rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. See MPEP 2136.05 and 706.02(b).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation naturally radioactive rare earth element in line 3, and the claim also recites several specific rare earth elements in lines 4-7, which is the narrower statement of the range/limitation. Specifically, at page 3, line 15 to page 4, line 2 of the

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specification, Applicants recite the rare earth element being any of the elements listed under atomic numbers 57-71 plus scandium and yttrium. However, the specifically recited compounds listed in lines 4-7 omit cerium and yttrium. Accordingly, it is not clear which specific elements are covered by the claim language. Since Applicants amended the claims to explicitly recite the specific elements, the Examiner assumed that the claim was intended to cover only those specific elements.

***Claim Rejections - 35 USC § 102***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Takimoto.

The inventor named in the instant application is the assignee of the applied reference. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131. The Examiner notes that the applied reference qualifies as prior

art under 35 U.S.C. 102(e) since it names a different inventive entity than the instant application.

With regard to claim 1, Takimoto discloses an air purification and physiological metabolism promoting health material, the features of which are that finely pulverized, naturally radioactive rare earth element is in an exposed state and adhesively adhered to the surface of a synthetic or natural base material (filtering member 3) in Fig. 1 and col. 2, lines 15-53. The Examiner notes that since the ions generated by the intake air filter will be emitted into the atmosphere through the engine exhaust gas, the air purification material of Takimoto is also inherently a physiological metabolism promoting health material.

With regard to claim 2, Takimoto discloses the finely pulverized naturally radioactive rare earth element being interlaced or adhesively bonded onto the base material in col. 2, lines 39-53.

With regard to claim 3, Takimoto discloses the base material being constructed as a sheet (the filter member substrate) in Fig. 1 and col. 2, lines 14-53.

With regard to claim 4, Takimoto discloses the rare earth element being blended for use as a single element or combination of two or more elements in col. 2, lines 39-40.

***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Greene whose telephone number is (571) 272-1157. The examiner can normally be reached on Monday - Friday (9:00 AM to 5:30 PM).




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason M. Greene  
Examiner  
Art Unit 1724

  
11/20/05

jmg  
November 20, 2005